

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully requested.

Claims 20 - 65 are pending in the application. Currently, claims 20 - 49 stand rejected and claims 50 - 65 stand withdrawn from consideration as being directed to a non-elected invention.

By the present amendment, claims 20, 33 - 37, and 41 have been amended; and claims 32 and 50 - 65 have been cancelled without prejudice. Applicant reserves the right to file a divisional application to the subject matter of claims 50 - 65.

In the office action mailed March 25, 2010, claims 20 - 49 were rejected under 35 U.S.C. 112, first paragraph; claims 20 - 40 and 42 - 49 were rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 6,077,613 to Gaffigan in view of US Patent Publication No. 2004/0197468 to Geel et al. or alternatively in view of U.S. Patent No. 4,163,813 to Sheets et al.; and claim 41 was rejected under 35 U.S.C. 103(a) as being unpatentable over Gaffigan in view of Geel et al. or Sheets et al. and further in view of U.S. Patent No. 5,569,505 to Nichols.

The foregoing rejections are traversed by the instant response.

With regard to the rejection of claims 20 - 49 under 35 U.S.C. 112, first paragraph, it is submitted that the rejection was erroneous. As acknowledged by the Examiner, page 6, third paragraph of the original specification states that the plastic surface coating is on one side or different sides, meaning the front and rear sides. The disclosure of the coating being on only one side means that the coating can be applied to either the front or the rear side. Thus, the omission of any reference in the claim to coating the rear side is not new matter. It is

a permissible broadening of the claim. There is nothing in the written description section of 35 U.S.C. 112, first paragraph, which says that Applicant must claim each and every feature of the invention in a single claim. If the Examiner believes that the first paragraph of 35 U.S.C. 112 is so limiting, then the Examiner is requested to cite legal precedent for such a position. Absent the citation of any legal precedent, the rejection should be withdrawn.

Similarly with regard to the ejection of claim 41, there is no requirement in the first paragraph of 35 U.S.C. 112, first paragraph that past tense can not be used. If the Examiner believes that the first paragraph of 35 U.S.C. 112 requires the use only of present tense, the Examiner is requested to cite legal precedent for such a position. Absent the citation of any legal precedent, the rejection should be withdrawn.

As amended herein, claim 20 is directed to a wooden material panel, including a surface coating applied at least on a front side, said surface coating being a multiple layer surface coating comprising at least one layer of plastic having a Shore hardness A up to 90, wherein the at least one layer of plastic borders on a layer of varnish or a layer of paint or pigments and wherein the at least one layer of plastic has a thickness between 20 μm and 300 μm .

The Gaffigan patent relied upon by the Examine discloses a sound insulating membrane. The membrane comprises at least one backing layer in contact with a layer of non-foam polymeric material. The backing layer(s) may be formed from any woven or nonwoven fabric of resinous fibers. The polymeric material has a Shore A hardness of from about 65 to 80 points, 5 seconds. The membrane is suitable for use under a surface coating like tiles, panels or similar surfaces and is not usable on the top

of surface coatings or between layers of multiple surface coatings such as paint and varnish. Furthermore, the insulation membrane only insulates against footfall sound, not ambient sound.

In making the obviousness rejection at issue, the Examiner refers to Fig. 4 of Gaffigan and the related description set out in col. 5, line 53 to col. 6, line 31. It is stated therein that three different products, namely a plurality of tiles, a sound insulating membrane, and a substrate are shown. Such an assembly is typical of a ceiling, floor or wall construction. Fig. 4 further shows a binder which is used to attach the tiles to the membrane. It is disclosed that the sound and acoustical isolation membrane is formed by a thermoplastic extrusion process.

The tiles of Fig. 4 are the equivalent wooden material panel. In order to render obvious the panel according to the invention set forth in claim 20, the tile should have a coating on at least the front side. However, as disclosed, the tiles do not have a surface coating on at least their front side. A coating is by nature different from a membrane. The membrane according to Gaffigan is an extrusion product. It is described and claimed as a membrane, not a coating. It is fixed upon the sub-floor and may be bound to a panel or tile. However, up to the building site, it is a separate product and only a binder binds the membrane to the rear side or underside of the panel or the tile.

A coating on the other hand is applied to the surface of a panel as a liquid. It is not a separate product such as Gaffigan's membrane, but is instead a part of a multiple layer surface coating on the panel.

Accordingly, Gaffigan does not disclose that said layer of plastic borders on a layer of varnish or a layer of paint or pigments. Instead, the membrane according to Gaffigan rests on the floor and is covered by a binder which covers the membrane in order to fix the tiles. The membrane according to Gaffigan is never exposed to the room. It is always covered by a flooring. The coating according to the present invention is instead on the surface of the panel which is immediately exposed to the room.

Further, the membrane according to Gaffigan comprises a sound insulating layer and a backing layer. The sound insulating layer has a minimum thickness of 0.51 mm. The backing layer has a minimum thickness of 0.1 mm, resulting in a minimum thickness of the entire membrane of 0.61 mm. While Gaffigan may aim at a very thin membrane, the best he can do is 0.61 mm which is needed to have an effective sound insulation. Thus, Gaffigan does not disclose a layer of plastic having a Shore hardness A up to 90 which has a thickness between 20 μm and 300 μm .

According to Gaffigan, the membrane may be a mat or veil which might be coated with decorative particles. However, such a decorative mat or veil with sound insulating properties is separate from the tiles and is not a coating, particularly a coating which is applied to the front surface of a panel. Geel does not cure this deficiency in Gaffigan because it does not disclose such an embodiment.

The Sheets patent describes an artistic and decorative and realistic coating material which is applied on boards or panels, e.g. construction insulation boards. Such a board according to Sheets comprises a varnish layer and it may comprise a layer of paint or pigments. Sheets aims at an artistic decorative and

realistic coating material. In fact, Sheets aims at a coating which cracks upon drying, thus allowing the layer of paint or pigments to penetrate into the coating. A separate layer of plastics with specific Shore hardness A of up to 90, applied as an extremely thin layer with the claimed thickness is suited to provide the type of board or coatings according to Sheets. Thus, Sheets does not cure the aforementioned deficiencies of Gaffigan and/or Geel.

For these reasons, claim 20 is allowable over the cited and applied references. Claims 21 - 31, 33 - 37, 39, 40 and 42 -49 are allowable for the same reasons as claim 20 as well as on their own accord.

With regard to the rejection of claim 41, the Nichols patent does not cure the aforementioned deficiencies of Gaffigan. Thus, at a minimum, claim 41 is allowable for the same reasons as claim 20. Nichols teaches a slab or panel construction comprising a fiber core glued between two facing sheets of thin metal with a specific moulding covering the edges of the panel. Although the panel may be covered by a veneer, it is not a panel of wooden materials. The focus of Nichols' invention is in the decorative moldings covering the edges of the panel. The panel proposed by Nichols is for furniture construction. The use as a construction board is not mentioned. Furniture surfaces are not treated with regard to insulation, especially acoustic insulation. Thus, one of ordinary skill in the art would not consider to improve a sound insulating membrane according to Gaffigan and/or Geel with the teachings of Nichols.

The instant application is believed to be in condition for allowance. Such allowance is respectfully submitted.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, the

Examiner is hereby invited to contact Applicant's attorney at the telephone number listed below.

The instant amendment after final rejection should be entered since it does not raise any issue which requires further consideration and/or search and does not raise any issue of new matter.

No fee is believed to be due as a result of this response.

If the Director determines that a fee is due in connection with this response, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,

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